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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,328	12/30/2005	Andreas Rochling	2400.0120000/SRL	6764
26111 7590 12/28/2007 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER HOLT, ANDRIAE M	
			ART UNIT 1616	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/563,328	Applicant(s) ROCHLING ET AL.	
	Examiner Andriae M. Holt	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/9/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-10 are pending in the application. Claims 1-10 will be examined on the merits. Examiner acknowledges preliminary amendment to claims submitted September 9, 2007.

Priority

Priority to PCT/EP04/06673 filed on June 21, 2004, which claims priority to German Foreign Application No. 10329714.6 filed on July 2, 2003 is acknowledged.

Information Disclosure Statement

Receipt of Information Disclosure Statement filed on March 9, 2007 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims an ethylene diamine alkoxylate derivative. The term "derivative" is indefinite. The word derivative, as defined by Merriam Webster's Collegiate Dictionary, Tenth Edition, is a chemical substance related structurally to another substance and theoretically derivable from it. While applicant is enabled for the particular ethylene diamine alkoxylate under the trade name Synperonic T/304®, on page 15, lines 20-21 of the specification. Applicant is not enabled for all derivatives as

defined by Webster of ethylene diamine alkoxyate. The specification does not enable any person skilled in the art to make the invention commensurate in scope of this claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Beestman et al. (WO 02/091828).

Examiner notes that components b-d of the formulation of claims 1 and 9 are optional ingredients, therefore, will not be examined as a part of the formulation.

Beestman et al. disclose a clear emulsifiable concentrate of a water-insoluble fungicide, e.g. strobilurin, without using nonylphenol ethoxylate that can be diluted in water to produce an aqueous ready-to-use formulation free from crystal formation or decomposition (page 2, Summary of Invention, paragraph 1). The composition consists essentially of a) water-insoluble fungicide, such as strobilurin (claims 1 and 9 agrochemical active ingredient, instant invention), b) a water-insoluble organic solvent, c) a water-insoluble, polar organic co-solvent, d) an anionic emulsifier, e) a free acid anionic emulsifier and f) a water-insoluble polymer with hydrophobic and hydrophilic groups. Beestman et al. disclose in table 1 on page 4, emulsifiable concentrate of the invention, examples of the components of the ready to use formulation, including a)

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strobilurin (one agrochemical active ingredient, instant invention), c) water-insoluble solvent, Agsol EX8 (claims 1 and 9, gamma-butyrolactone, instant invention), f) water-insoluble polymer, Agrimer AL-22 (claims 1 and 9, emulsion stabilizer, instant invention). It is inherent that the formulation will be used as a plant protection agent as strobilurins are a class of well known and widely used water insoluble fungicides that treat or protect plants in their habitat (claim 10, method of use instant invention).

Beestman disclose all the limitations of claims 1 and 9-10.

Claims 1-3, 6 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Aven et al. (EP 1,025,757).

Examiner notes that components b-d of the formulation of claims 1 and 9 are optional ingredients, therefore, will not be examined as a part of the formulation.

Aven et al. disclose a novel stable non-aqueous emulsifiable concentrate (EC) formulation for crop protection (page 2, paragraph 9). Aven et al. disclose an EC consisting essentially of a) at least one pesticidal crop protection active compound (claims 1 and 9, agrochemical active ingredient, instant invention); b) a solvent selected from the group consisting of diethyleneglycol, dialkylethers, aromatic hydrocarbons, aliphatic hydrocarbons and esters of plant oils or mixtures thereof; c) a co-solvent selected from the group consisting of gamma-butyrolactone (claims 1 and 9, gamma-butyrolactone, instant invention), d) an emulsifying surfactant system which is a mixture of anionic and non-ionic surfactants, e) at least one perfluoro-(C₆₋₁₈)-alkylphosphonic acids and f) a stabilizing agent and/or antioxidant (claims 1 and 9, stabilizing agent, instant invention). Aven et al. disclose preferred non-ionic surfactants are alcohol

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alkoxylates (page 6, paragraph 47) (claim 2, ethylene diamine alkoxylate derivative, instant invention). Aven et al. further disclose particularly are Synperonic ® alcohol ethoxylates from Uniqema (page 6, paragraph 48) (claim 3, Synperonic ®, instant invention). Aven et al. disclose that preferred fungicide include trifloxystrobin (claim 6, trifloxystrobin, instant invention). Aven et al. disclose the invention also concerns a method of combating pests at a locus which comprises treating the locus with a composition obtained from emulsifying an EC according to the invention in water (page 8, paragraph 64) (claim 10, method of use, instant invention). Aven et al. further disclose several examples of the EC formulations, particularly, examples 4, 5, 6-7, and 13-14 on pages 10-16.

Aven et al. disclose all the limitations of claims 1-3, 6, and 9-10

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aven et al. (EP 1, 025, 757) in view of Wachendorff-Neumann et al. (WO 2004/000022).

Applicant's Invention

Applicant claims an agrochemical formulation comprising at least one agrochemical active ingredient, gamma-butyrolactone, an emulsion stabilizer and/or a crystallization inhibitor. Applicant further claims the agrochemical active ingredient can be prothioconazole, fluoxastrobin, or trifloxystrobin or combinations of the active ingredients. Applicant claims a method of contacting the formulation in the habitat of the plants to be treated and/or protected.

Determination of the scope of the content of the prior art

(MPEP 2141.01)

The teachings of Aven et al. are referenced herein above and the teachings are used in the instant rejection.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Aven et al. do not teach the use of prothioconazole of claim 4, fluoxastrobin of claim 5 or the combinations of claims 7-8, as the active agrochemical ingredient. It is for this reason Wachendorff-Neumann et al. is joined.

Wachendorff-Neumann et al. teaches the use of an active combination which comprises on the one hand, two known oxime ether derivatives and on the other hand,

a known hydroxyethyltriazole derivative that is suitable for controlling phytopathogenic fungi (page 1, lines 4-7). Wachendorff-Neumann et al. teach it has been found that the novel active compound combinations comprising trifloxystrobin (claim 6, trifloxystrobin, instant invention) (page 1, lines 28-30 –page 2, lines 1-3), prothioconazole (claim 4, prothioconazole, instant invention)(page 2, lines 4-8) and fluoxastrobin (claim 5, fluoxastrobin, instant invention)(page 2, lines 10-16) has very good fungicidal properties (claims 7-8, combination of active ingredients, instant invention).

Wachendorff-Neumann et al. further teach the fungicidal action of the active compound combination according to the invention is considerably higher than the sum of the actions of the individual active compounds (page 3, lines 1-4). Wachendorff-Neumann et al. teach the active compound combinations according to the invention can be converted to the customary formulations, such as solutions, and emulsions (page 6, lines 22-25). Wachendorff-Neumann et al. teach the active compound combinations according to the invention can also be applied in a mixture with known fungicides to broaden the activity spectrum or the prevent the development of resistance (page 8, lines 8-13)

Finding a prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Aven et al. and Wachendorff-Neumann et al. to produce an emulsifiable concentrate formulation for crop protection active compounds because Aven et al. teach it is within the skill of the art to produce an emulsifiable

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concentrate comprising at least one pesticidal crop protection compound, including trifloxystrobin, that shows excellent selective pesticidal activity and Wachendorff-Neumann et al. teach the use of combinations of active compounds, prothioconazole, fluoxastrobin and trifloxystrobin that are excellent in controlling phytopathogenic fungi that can be formulated into an emulsion. In view of *In re Kerkhoven*, 205 USPQ 1069 (C.C.P.A. 1980), it is *prima facie* obvious to combine two or more compositions each of which is taught by prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in prior art, thus claims that requires no more than mixing together two or three conventional fungicides set forth *prima facie* obvious subject matter. Therefore, one skilled in the art at the time of invention would have been motivated to combine fungicides, as taught by Wachendorff-Neumann et al. and substitute the individual compounds or combination of compounds for the active ingredient as taught by Aven et al. to produce an emulsifiable concentrate formulation that shows excellent pesticidal activity in various crops. Given the state of the art as evidenced by the teachings of the cited references, and absent any evidence to the contrary, there would have been a reasonable expectation of success in combining the teachings of the cited references to form an emulsifiable concentrate formulation that is free from crystal formation based on the other components of the formulation and that would have an increased spectrum of activity and/or prevent the development of resistance.

None of the claims are allowed.

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Conclusion

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andriae M. Holt whose telephone number is 571-272-9328. The examiner can normally be reached on 9:00 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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